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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,835	12/13/2000	Vernon Keith Boland	8598	5833

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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,835

Applicant(s)

BOLAND ET AL.

Examiner

Igor Borissov

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Upon reconsideration, the finality of the last Office Action of 10/07/03 has been withdrawn.

Claim Objections

Claim 7 is objected to because of the following informalities: **claim 7** recites limitations of **claim 6**, which is canceled by the Applicant.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-5, 7, 11-12 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gardenswartz et al. (6,298,330).

Gardenswartz et al. (hereinafter Gardenswartz) teaches method and system for communicating with a customer's computer based on the offline purchase history of the consumer, comprising:

Claims 1 and 18. Storing customer purchase history (*historical interaction data*) in a database and associating an add profile with the customer terminal identification number (C. 5, L. 39-41); receiving a URL request (*interaction data*) from the customer over the Internet (C. 13, L. 58-60); matching the identification/cookie number received from the customer terminal with said associated add profile (C. 13, L. 65-67); delivering

an advertisement (*context*) to the customer based on information stored in said add profile (C. 14, L. 1-4).

Claims 2 and 19-20. Receiving communication over the Internet (C. 13, L. 58-60). Information as to access *channel* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claims 4 and 11. See **claim 1**.

Claims 5 and 12. Delivering an advertisement (a context) to the customer (C. 14, L. 1-4) inherently indicates customer's ability to act upon it.

Claim 7. See **claim 1**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 8-10, 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz.

Claim 8. Gardenswartz teaches: storing customers purchase history (*historical interaction data*) in a database (C. 10, L. 5-7); receiving a URL request (*interaction data*) from the customer over the Internet (C. 13, L. 58-60); matching the identification/cookie number received from the customer terminal with said associated add profile (C. 13, L. 65-67); delivering an advertisement (*context*) to the customer based on information stored in said add profile (C. 14, L. 1-4).

However, Gardenswartz does not specifically teach that said database, which includes purchase history of *customers*, includes purchase history of *previous* customers.

Official notice is taken that it is well known to generate targeted advertisement for consumers based on analysis of existing historical purchase history (See, for example, Gardenswartz; C. 14, L. 17-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gardenswartz to include that said database, which stores purchase history of *customers*, includes purchase history of *previous* customers, because it would allow to predict possible purchase behavior of new customers, thereby make said advertising more effective.

Claim 3. See **claim 8.**

Claim 9. See **claim 2.**

Claim 10. See **claim 8.**

Claim 13. Gardenswartz teaches: receiving a URL request from the customer over the Internet, including the customer terminal identification number (C. 5, L. 39-41) and customer registration data (*Internet session history data*) (C. 6, L. 63-64); matching the identification/cookie number received from the customer terminal with said associated add profile (C. 13, L. 65-67); generating an advertisement (*response*) to the customer based on information stored in said add profile, and delivering said advertisement to the customer over e-mail (C. 7, L. 19-25).

However, Gardenswartz does not specifically teach that said customer *request is received over e-mail*.

Official notice is taken that it is well known to use e-mail for communication over the Internet.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gardenswartz to include that said customer request is received over e-mail, because it would allow to transmit information almost instantly, thereby save time.

Claim 15. Retrieving by customer's computers Web pages of the registration server via the Internet (C. 6, L. 48-56) obviously indicates *generating a template e-mail on the customer's terminal*.

Claim 16. See claim 15.

Claim 17. See claim 13.

Response to Arguments

Applicant's arguments with respect to **claims 1-5, 7-13 and 15-20** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

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